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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,128	10/18/2005	Susumu Kobayashi	F-8789	1361
28107 7590 06/26/2008 JORDAN AND HAMBURG LLP 122 EAST 42ND STREET SUITE 4000 NEW YORK, NY 10168			EXAMINER TRAN, HANH VAN	
			ART UNIT 3637	PAPER NUMBER
			MAIL DATE 06/26/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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JUN 25 2008

TECHNOLOGY CENTER 3600

Jordan and Hamburg LLP  
122 East 42<sup>nd</sup> Street  
Suite 4000  
New York, New York 10168

In re Application of:  
Susumu Kobayashi  
Application No. 10/550,128  
Filed: October 18, 2005  
For: RAIL FIXING PART STRUCTURE

:  
: DECISION ON PETITION  
: REGARDING REQUEST  
: TO WITHDRAW FINALITY  
:

This is in response to applicant's petition, filed on March 26, 2008, to request the withdrawal of the finality of the final rejection mailed on January 28, 2008 as being improper.

The petition is **DENIED**.

Applicant alleges that the finality was improper because claim 1, as amended by the amendment filed on November 05, 2007, merely placed the claim in better form without changing the scope of the claim. In other words, the changes made in claim 1 were not substantive. Applicant alleges that by changing the language of "being resin" to "comprising resin", applicant merely made a formalistic change, not a substantive change. Similarly, other changes made in claim 1 such as changing the wording of "a flange provided at said rail" to "said rail comprising a flange", "extending" to "extends", "said metal rail fixed to said drawer" to "said metal rail is fixed to said drawer", and "ribs provided at a side surface of said drawer" to "said drawer has said ribs at a side surface of said drawer" are not substantive changes.

Applicant alleges that as the changes made in claim 1 were not made to overcome the examiners' rejection, the amendment would not necessitate a new ground of rejection. Therefore, the examiner's new rejection of claim 1 cannot be made final. As a result, the finality of the office action mailed on January 28, 2008 was improper.

A review of the application reveals that original claims 1-3 were rejected on 102(b) on Hays in the first Office action mailed on July 05, 2007. Subsequently, applicant submitted an amendment on November 05, 2007 amending claims 1-3 and adding new claims 4-10. The examiner rejected claims 1-3, and 7 on 103(a) over US patent 6,217,139 to Henriott et al. in

view of US patent 6,010,200 to Hays, and claims 4-6 and 8-10 on 102 (b) as being anticipated by US patent 6,217,139 to Henriott et al. in the final Office action mailed on January 28, 2008. On March 26, 2008 applicant filed the instant petition requesting the withdrawal of the finality of the final rejection mailed on January 28, 2008 as being improper.

In close review of the amendment dated November 05, 2007, it is noted that some changes made in claim 1 such as "extending" to "extends", and "said metal rail fixed to said drawer" to "said metal rail is fixed to said drawer" are not consider substantive changes. Applicant is correct in considering that these changes are merely formalistic in nature. However, other changes such as "being resin" to "comprising resin", "a flange provided at said rail" to "said rail comprising a flange", and "ribs provided at a side surface of said drawer" to "said drawer has said ribs at a side surface of said drawer" are clearly substantive changes. The language of "being resin" is a closed ended limitation whereas the language of "comprising resin" is an open ended limitation which is much broader in scope. The language of "a flange provided at said rail" does not require a flange to be a part of the rail whereas "said rail comprising a flange" requires a flange to be a part of the rail. As such, these changes are clearly substantive in scope. Similarly, the language of "ribs provided at a side surface of said drawer" does not required the ribs to be a part of the drawer whereas "said drawer has said ribs at a side surface of said drawer" requires the ribs to be a part of the drawer. Again, this change is clearly substantive in scope.

Taken as a whole, the amendment to claim 1 is clearly substantive in nature by changing the scope of the claim.

MPEP § 706.07(a) states that:

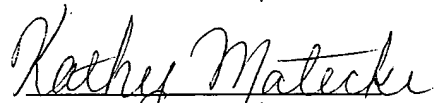
"second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p)."

Since the amendment to claim 1 clearly changed the scope of the claim, it necessitates a new ground of rejection.

Based on the above facts, it is determined that the amendment filed on November 5, 2007 was substantive in scope and the changes made to claim 1 were substantive in nature. The amendment therefore necessitates a new ground of rejection. The finality of the rejection mailed on January 28, 2008 is deemed proper.

**SUMMARY: The petition is DENIED.**

Any questions regarding this decision should be directed to Supervisory Patent Examiner  
Lanna Mai at 571-272-6867.

  
Kathy Matecki, Director  
Technology Center 3600  
(571) 272-5250

lm/tl: 5/30/08